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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,599	12/17/2001	Klaus Turina	43605-00028	2868
38065	7590	10/31/2005	EXAMINER	
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR C11 PLANO, TX 75024			TRAN, PHUC H	
			ART UNIT	PAPER NUMBER
			2668	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,599

Applicant(s)

TURINA ET AL.

Examiner

PHUC H. TRAN

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 January 1977.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/17/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/10/03, 3/26/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. The abstract of the disclosure is objected to because the term “ (Fig.3) “ in the abstract should be deleted. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claim 57 is rejected under 35 U.S.C. 101 because it is a computer program per se.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 10 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10 lines 3-7, "the signaling connection control part", "the MTP3 user adaptation layer", "the ISDN user adaptation layer" and "the V5.2 user adaptation layer" have no antecedent basis. Similar problems exist in claim 27.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-77 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,826,198. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because of the following formalities:

For claims 1-77, the claims 1-20 of the patent number 6,826,198 disclose a system/method comprising: a first protocol implementation unit adapted to run a signaling control layer of the protocol stack on top of a packet transfer network for exchange of signaling data via at least one signaling association; a second protocol implementation unit adapted to run a user adaptation layer of the protocol stack on top of the signaling control layer for support of signaling connection control services used by the signaling source node;

wherein a name mapping unit is adapted to receive a signaling target node name from the signaling source node and to map the signaling target node name into a peer signaling association;

wherein the name mapping unit is comprised in the second protocol implementation unit; wherein the name mapping unit comprises a mapping data interface unit adapted to distribute and/or receive signaling association attributes via the signaling control layer;

wherein the name mapping unit comprises a memory unit adapted to store signaling association attributes locally in the communication apparatus; a first protocol implementation unit adapted to run a signaling control layer of the protocol stack on top of a packet transfer network for exchange of signaling data via at least one signaling association; a second protocol implementation unit adapted to run a user adaptation layer of the protocol stack on top of the signaling control layer for support of signaling connection control services used by the signaling source node;

wherein a name mapping unit is adapted to receive a signaling target node name from the signaling source node and to map the signaling target node name into a peer signaling association; and the mapping unit further comprises a target node name resolution unit adapted to map a destination name into the peer signaling association according to a specified algorithm; wherein the target node name resolution unit is of a client/server type responding to name translation requests from signaling source node clients in a local and/or remote manner;

wherein the target node name resolution unit is further adapted to consider at least one criterion selected from a group comprising target node capability, target node load, and routing criteria association attributes to map the signaling target node name into the peer signaling association; a first protocol implementation unit adapted to run a signaling control layer of the protocol stack on top of a packet transfer network for exchange of signaling data via at least one signaling association; a second protocol implementation unit adapted to run a user adaptation layer of the protocol stack on top of the signaling control layer for support of signaling connection control services used by the signaling source node;

wherein a name mapping unit is adapted to receive a signaling target node name from the signaling source node and to map the signaling target node name into a peer signaling association, and the name mapping unit further comprises a fault management unit adapted to detect an inoperative peer signaling association and/or an inoperative signaling transport address in a peer signaling association and to select another signaling transport address under the same signaling target node name; running a signaling control layer of the protocol stack on top of a packet transfer network for exchange of signaling data via at least one signaling association; running a user adaptation layer of the protocol stack on top of the signaling control layer for

support of signaling connection control services used by the signaling source node; receiving a signaling target node name from the signaling source node and mapping the signaling target node name into a peer signaling association; which comprises a step to check an availability of the peer signaling association and triggering a build-up thereof; which further comprises a step distributing and/or receiving signaling association attributes via the signaling control layer; which further comprises the step of storing signaling association attributes locally at the signaling source node; running a signaling control layer of the protocol stack on top of a packet transfer network for exchange of signaling data via at least one signaling association; running a user adaptation layer of the protocol stack on top of the signaling control layer for support of signaling connection control services used by the signaling source node; receiving a signaling target node name from the signaling source node and mapping the signaling target node name into a peer signaling association; wherein the mapping of the signaling target node name into the peer signaling association is carried out according to a specified algorithm; wherein the specified algorithm is a query responsive database algorithm; wherein the specified algorithm is a table lookup algorithm; running a signaling control layer of the protocol stack on top of a packet transfer network for exchange of signaling data via at least one signaling association; running a user adaptation layer of the protocol stack on top of the signaling control layer for support of signaling connection control services used by the signaling source node; receiving a signaling target node name from the signaling source node and mapping the signaling target node name into a peer signaling association; considering at least one criterion selected from a group comprising target node capability, target node load, and routing criteria association attributes when mapping the signaling target node name into the peer signaling association; running a

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signaling control layer of the protocol stack on top of a packet transfer network for exchange of signaling data via at least one signaling association; running a user adaptation layer of the protocol stack on top of the signaling control layer for support of signaling connection control services used by the signaling source node; receiving a signaling target node name from the signaling source node and mapping the signaling target node name into a peer signaling association; detecting an unreachable peer signaling association and/or an unreachable signaling transport address in a peer signaling association and selecting another signaling transport address under the same signaling target node name; running a signaling control layer of the protocol stack on top of a packet transfer network for exchange of signaling data via at least one signaling association; running a user adaptation layer of the protocol stack on top of the signaling control layer for support of signaling connection control services used by the signaling source node; receiving a signaling target node name from the signaling source node and mapping the signaling target node name into a peer signaling association; maintaining a data base storing name spaces and/or association attributes and updating the data base; wherein the updating of the data base at least comprises one step selected from a group comprising signaling node registration, mapping node registration, signaling node deregistration, mapping node deregistration, and signaling node routing policy change registration; and comprising software code portions for performing the steps of claim 9 when the product is run on a processor of the communication device.

NOTE: See claims 1-20 of U.S. Patent No. 6,826,198.

Applicant's claims 1-77 merely broaden the scope of claims 1-20 of U.S. Patent No. 6,826,198 by eliminating the terms "at least one signaling association" and "a peer signaling

association” from claims 1, 5, 8, 9, 13, 16, 17, and 18 of the patent. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not need would be obvious to one skilled in the art.

8. Note: The term “ adapted to “ is not positively recited claim limitation. Therefor, the limitations following the “adapted to “ are not considered the claimed limitation. It is suggest Applicant to remove the term from the claims.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1,11,16,57,62, and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Gobbi et al. (2002/0044558).

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- For Claims 1,11,16,57,62, and 65, Gobbi et al. disclose a system comprising a first implementation, a second implementation unit and a mapping unit (see paragraph 0043 of the patent).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO form 892

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUC H. TRAN whose telephone number is (571) 272-3172. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chieh M. Fan can be reached on (571) 272-3042. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Assistant Examiner
Art Unit 2664

P.t
10/26/05


DANG TON
PRIMARY EXAMINER